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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,141	07/25/2003	Juan Carlos de la Torre	TSRI 465.0 D2	4125
26621	7590	05/12/2005	EXAMINER	
THE SCRIPPS RESEARCH INSTITUTE OFFICE OF PATENT COUNSEL, TPC-8 10550 NORTH TORREY PINES ROAD LA JOLLA, CA 92037			CHEN, STACY BROWN	
			ART UNIT	PAPER NUMBER
			1648	

DATE MAILED: 05/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/627,141

Applicant(s)

DE LA TORRE, JUAN CARLOS

Examiner

Stacy B. Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5-59 is/are pending in the application.
- 4a) Of the above claim(s) 5-11, 16-27, 31-33 and 35-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-15, 28-30, 34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Applicant's election of Group III, 12-15, 28-30 and 34, without traverse, is acknowledged. Claims 5-59 are pending. Claims 5-11, 16-27, 31-33 and 35-59 are withdrawn from consideration being drawn to non-elected inventions. Claims 12-15, 28-30 and 34 are under examination. Claim 34 is examined only with respect to the elected subject matter relating to claim 29, from which claim 34 depends. The other embodiments of claim 34 are not under examination.

### ***Information Disclosure Statement***

2. The information disclosure statement filed October 4, 2004 is missing the PTO Form 1449. Applicant is requested to submit a copy of the 1449.

### ***Claim Objections***

3. Claims 12-15 are objected to because of the following informalities: The claims recite sequence identifiers, which should be "SEQ ID NO:". The instant claims do not have a colon (":") after "NO". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12-15, 28-30 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

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applicant regards as the invention. The claims are drawn to a substantially purified nucleic acid encoding a human Borna disease virus (BDV) p40 polypeptide consisting essentially of an amino acid residue sequence selected from the group consisting of SEQ ID NO: 28, 29, 30, 39, 40 and 41. Specifically, the nucleic acid sequence consists of a nucleotide sequence of SEQ ID NO: 14, 15 or 16. Also claimed are vectors and host cells.

Claims 13-15 are drawn to embodiments of claim 12 wherein the polynucleotide sequence consists of SEQ ID NO: 14, 15 or 16. It is unclear which amino acid of claim 12 is encoded by SEQ ID NO: 14-16. The metes and bounds of the claims are unclear because SEQ ID NO: 14, for example, does not encode all of the amino acid sequences listed in claim 12. Each of SEQ ID NO: 14-16 consists of 571 nucleotides, which encode amino acid sequences of 157 amino acids. Some of the amino acid sequences in claim 12 consist essentially only of 18-19 amino acids. The specification does not disclose which nucleic acid sequence encodes which amino acid sequences.

The claim language of claims 13-15 is closed because “consisting of” limits the claims to the exact subject matter recited, nothing more and nothing less. Given this meaning, the sequences of claims 13-15 can only encode amino acid sequences of 157 amino acids. Although the claim language of claim 12 is open, “consisting essentially of”, the closed language of claims 13-15 limits the length of the amino acid sequences of claim 12. Clarification and correction are required.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 12-15, 28-30 and 34 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 7 of U.S. Patent No. 6,057,094. Although the conflicting claims are not identical, they are not patentably distinct from each other because the active ingredient in the patented kit claim is a nucleotide sequence that encodes SEQ ID NO: 39, 40 and 41. The pending claims are drawn to nucleotide sequences, vectors and host cells comprising nucleotide sequences that encode SEQ ID NO: 39, 40 and 41. The sequences, vectors and host cells would have obvious at the time of the instant invention because Applicant disclosed such embodiments in their original disclosure. The active ingredient is the same between the patented and pending claims. Therefore, the instant claims are unpatentable over claim 7 of Applicant's 6,057,094 patent.

### ***Conclusion***

6. No claim is allowed. SEQ ID NO: 28, 29, 30, 39, 40, 41, 13, 14 and 15 are free of the prior art of record.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stacy B. Chen whose telephone number is 571-272-0896. The examiner can normally be reached on M-F (7:00-4:30). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James C. Housel can be reached on 571-272-0902. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



Stacy B. Chen

May 6, 2005